



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,790	01/27/2004	Scott Malat	14846-38	3985

28221 7590 02/01/2007  
PATENT DOCKET ADMINISTRATOR  
LOWENSTEIN SANDLER PC  
65 LIVINGSTON AVENUE  
ROSELAND, NJ 07068

EXAMINER
----------

TAYLOR, BARRY W

ART UNIT	PAPER NUMBER
----------	--------------

2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/766,790

Applicant(s)

MALAT ET AL.

Examiner

Barry W. Taylor

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/27/04</u> .   | 6) <input type="checkbox"/> Other: ____                           |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-7 and 9-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapeze et al (2004/0176973 hereinafter Lapeze) in view of Shoemaker et al (2005/0182767 hereinafter Shoemaker).

Regarding claim 18. Lapeze teaches a system for managing call reports, comprising:

a server (item 12 figure 1) configured to receive from a wireless device (item 18 figure 1) a message and information regarding a client matter (see figures 1-7, paragraphs 007 – 0012, 0014, 0016, 0036, 0037 – 0042, 0047, 0052, 0054, 0058 –

Art Unit: 2617

0064, 0078 wherein an attorney and his administrative assistant can jointly maintain the attorney's call list and make modifications to the data set using a RIM PDA or other wireless device), create a call report including the received message (paragraphs 007 – 0012, 0014, 0016, 0036, 0041, 0052, 0054, 0059 – 0069).

Lapeze does not explicitly show determining a distribution list by applying a set of visibility rules and allow remote access to the call report based on the distribution list. However, Lapeze does teach authenticating the user based on security and/or access credentials (paragraph 0008) and access privileges (paragraph 0054).

Shoemaker also teaches wireless devices in communication with server (paragraphs 0049, 0054) wherein users can assign and edit contact list to have clearance levels and privacy levels (paragraphs 0056, 0064, 0067, 0082, 0089 – 0090, 0092, 0097) thereby allowing users the ability to control and/or customize the amount of data and types of data, that can be accessed by each contact in the users contact list (paragraph 0090).

It would have been obvious for any one of ordinary skill in the art at the time of invention to use clearance levels and privacy levels as taught by Shoemaker into the teachings of Lapeze thereby controlling the amount of data a user can view, as well as, controlling who can view the data as taught by Shoemaker (paragraphs 0089 – 0090)

Regarding claim 19. Shoemaker teaches wherein the visibility rules include rules for determining which persons are legally allowed access to the call report (paragraphs 0064, 0082, 0089 – 0090, 0092, 0097).

Regarding claim 20. Shoemaker teaches wherein the visibility rules are adjustable (paragraphs 0064, 0082, 0089 – 0090, 0092, 0097).

Regarding claim 21. Shoemaker teaches wherein the visibility rules take into consideration whether the call report involves a sensitive subject (paragraphs 0082 – 0083, 0089 – 0089, 0092).

Regarding claim 22. Shoemaker teaches wherein the information regarding the client matter includes a user-provided sensitivity indicator (paragraphs 0082 – 0083, 0089 – 0089, 0092).

Regarding program claim 23. Program claim 23 is rejected for the same reasons as system claim 18 and method claim 1 since the recited system and method would perform the claimed program steps.

Regarding claim 1. Method claim 1 is rejected for the same reason as system claim 18 since the recited apparatus would perform the claimed method steps.

Regarding claim 2. Shoemaker teaches wherein the visibility rules take into consideration whether the call report involves a sensitive subject (paragraphs 0082 – 0083, 0089 – 0089, 0092).

Regarding claim 3. Shoemaker teaches wherein the visibility rules include rules for determining which persons are legally allowed access to the call report (paragraphs 0064, 0082, 0089 – 0090, 0092, 0097).

Regarding claim 4. Shoemaker teaches wherein the visibility rules are adjustable (paragraphs 0064, 0082, 0089 – 0090, 0092, 0097).

Regarding claim 5. Shoemaker teaches wherein the information regarding the client matter includes a user-provided sensitivity indicator (paragraphs 0082 – 0083, 0089 – 0089, 0092).

Regarding claim 6. Lapeze teaches wherein the call report is at least partly based on a template (abstract, see “FonSheet” in figures 2-6, paragraphs 0007 – 0012).

Regarding claim 7. Lapeze teaches wherein the call report is remotely accessible (see Research In Motion Personal Digital Assistant - item 18 figure 1).

Regarding claim 9. Lapeze teaches wherein the call report is accessible via the wireless network (see Research In Motion Personal Digital Assistant - item 18 figure 1 used to access call report from wireless network --- paragraph 0045).

Regarding claim 10. Lapeze teaches wherein the call report is accessible using a wireless device (see Research In Motion Personal Digital Assistant - item 18 figure 1 used to access call report from wireless network --- paragraph 0045).

Regarding claim 11. Lapeze teaches wherein the wireless device is browser-based (see Research In Motion Personal Digital Assistant - item 18 figure 1 used to access call report from wireless network --- paragraph 0045 wherein the RIM PDA is

browser-based --- paragraphs 0041 – 0042, 0046 – 0048, 0051 – 0053, 58, 70, 76 and claims 50 and 52-56).

Regarding claim 12. Lapeze teaches wherein the wireless device includes an Internet connection (paragraphs 0006, 0041 – 0043, 0045, 0048, 0077 and claims 11 and 25).

Regarding claim 13. Lapeze teaches wherein the wireless device has an on-line mode and an off-line mode (paragraph 0012).

Regarding claim 14. Lapeze teaches wherein the message is entered using the wireless device in the off-line mode and automatically transmitted when the device is in the on-line mode (paragraph 0012).

Regarding claim 15. Lapeze teaches wherein the wireless device is in the off-line mode when a network connection is unavailable (paragraph 0012).

Regarding claim 16. Lapeze teaches wherein a list of contacts is displayed to a user (see claims 15, 16, 35 and 37).

Regarding claim 17. Lapeze teaches wherein the list of contacts is modifiable by the user (paragraphs 0002, 0006, 0007, 0012, 0014, 0015, 0017, 0020, 0027, 0030, 0062).

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lapeze et al (2004/0176973 hereinafter Lapeze) in view of Shoemaker et al (2005/0182767 hereinafter Shoemaker) further in view of Yach et al (2002/0128036 hereinafter Yach).

Regarding claim 8. Lapeze in view of Shoemaker do not show wherein the call report is distributed via electronic mail (e-mail) to persons in the distribution list.

Art Unit: 2617

Yach also teaches a wireless mobile wherein user can takes notes on current call and then copy and paste the call log notes into an email message so as to be forwarded to another user to recount the phone conversation (paragraphs 0107 – 0108).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Lapeze in view of Shoemaker to compose an email message as taught by Yach thereby allowing a user while talking to one person to easily send a email message to another user recounting the phone conversation as taught by Yach (paragraph 0107).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Thursday, 6:30am to 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost, can be reached at (571) 272-7872. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Centralized Delivery Policy:** For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the central fax number (571-273-8300).

Barry W. Taylor  
Art Unit 2617

 11/26/07  
BARRY TAYLOR  
PRIMARY EXAMINER